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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/892,790	06/28/2001	Ki-Ook Park	P56525RE	1084

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EXAMINER

TUPPER, ROBERT S

ART UNIT PAPER NUMBER

2652

DATE MAILED: 07/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/892,790

Applicant(s)

PARK ET AL.

Examiner

Robert S Tupper

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-20 is/are allowed.
- 6) ☒ Claim(s) 21-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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1. The disclosure is objected to because of the following informalities: the amendments made to the specification and claims in the preliminary amendment of 6/28/01 have not been presented in proper format. Additions must be underlined and deletions must be bracketed. THIS MUST BE DONE IN THE "CLEAN COPY" SINCE THAT IS USED FOR PRINTING.

Appropriate correction is required.

2. Claims 21-60 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The following limitations have been omitted from the newly presented reissue claims: "first and second projections" defining "first and second air bearing surfaces" (claims 21, 31, 42, 52, 55, and 58); "arcuate front wall portion" (claims 21, 31, as now

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amended 42, 52, 55, and 58), and "third and fourth air bearing surfaces" (claims 21, 52, 55, and 58).

In the amendment of 12/01/98 in the parent application Applicant specifically argued (see remarks on pages 11-12) the following structural features to defined over the 102 rejection based upon CHAPIN et al (5,200,868): (a) an arcuate front wall, (b) third and fourth air bearing surfaces, and (c) four separate air bearing surfaces.

3. Claims 21-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 , as now amended, fails to recite any reference for the locations of the listed features.

Claim 31 fails to recite a reference for the "first direction".

Note that the patented claims referenced the features to the rotational direction of the medium confronted by the slider.

4. Claims 21-60 are rejected under 35 USC 112, first and second paragraphs, as the claimed invention is not described in such full, clear, concise, and exact terms as to enable any person skilled in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

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The original disclosure showed slider configurations with two separate front air bearing surfaces and a U-shaped cross rail with side extensions on each side, each side extension terminating near the rear edge with an air bearing surface. There is NO disclosure of other configurations. There is NO disclosure of a slider having: (A) a cross rail without the two separate front air bearing surfaces, (B) a cross rail with only one side extension, (C) only a total of one air bearing surface between the two side extensions, or (D) the side extensions having different lengths, with only one terminating before the trailing end of the slider.

These claims are inadequately disclosed under 112 par.1 if read to encompass slider configurations not having ALL of the critical features listed above.

These claims are indefinite and incomplete under 112 par.2 for failing to recite all of the critical features.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6. Claims 21, 30-32, and 41 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by NEPELA (5,568,981).

Note figures 4b, 4c, 5b, 5c, and 5d. NEPELA et al shows a slider with a U-shaped platform with a negative pressure cavity (not numbered) behind a cross rail 98

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having side wall portions (not numbered) that have an arcuate section and terminate before the rear edge of the slider, and a rear center platform 90 for mounting the transducer.

7. Applicant's arguments filed 6/18/01 have been fully considered but they are not persuasive.

Concerning the recapture rejection, the Examiner simply does not agree with Applicant's characterization of the prosecution of the parent application. It is the Examiner's position that Applicant clearly amended the originally filed claims to add "arcuate" and "third and fourth air bearing surfaces". Furthermore, Applicant specifically argued that those features, plus the resultant four separate air bearing surfaces were the basis for defining over the rejections made in the first Office Action.

Concerning the 112 par.1 and/or par.2 rejection, the issue is one of enablement. It is the Examiner's position that the scope of the rejected claims is not enabled. As stated above in the rejection, there is NO disclosure of a slider having: (A) a cross rail without the two separate front air bearing surfaces, (B) a cross rail with only one side extension, (C) only a total of one air bearing surface between the two side extensions, or (D) the side extensions having different lengths, with only one terminating before the trailing end of the slider. The added claims encompass these configurations and are not enabled.

Concerning the 112 par.2 rejection of claims 21(as just amended)-41, Applicant argues that the rejection is moot in view of amendments made in claim 31. This is in

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error. There is no reference recited for the “first direction”. Applicant also amended claim 21 to remove the recitations stating the location of the U-shaped air bearing platform, thus rendering that group of claims indefinite too.

Concerning the 102 rejection over NEPELA et al, Applicant argues that there is no “U-shaped air bearing platform defining the negative pressure cavity”. This is in error. The cited figures in NEPELA et al clearly show a cross rail with side wall portions extending towards the trailing edge. These define a negative pressure area.

**8. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert S Tupper whose telephone number is 703-308-

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1601. The examiner can normally be reached on Mon - Fri, 6:00 AM - 3:30 PM (first Fri off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa Nguyen can be reached on 703-305-9687. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4750.



Robert S Tupper  
Primary Examiner  
Art Unit 2652

rst  
July 3, 2002